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Dated: October 28, 2008 Signature: /Mark D. Russett/
Mark D. Russett, Reg. No. 41,281

Docket No.: 66585(70820)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Tsuneo Yasuma et al.

Application No.: 10/525,158

Confirmation No.: 5896

Filed: February 22, 2005

Art Unit: 1624

For: SUBSTITUTED PYRAZOLO[1,5-
A]PYRIMIDINES AS CALCIUM RECEPTOR
MODULATING AGENTS

Examiner: Moore, Susanna

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705(b)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Request for Reconsideration of Patent Term Adjustment (PTA) under 37 C.F.R. § 1.705(b) (or, alternatively, a Petition for Review of Patent Term Adjustment under 37 C.F.R. §§ 1.181 & 1.705(b), if appropriate) to correct the Patent Term Adjustment for the above-referenced patent application.

It is respectfully submitted that the Patent Term Adjustment of five hundred forty-five (545) days accorded by the Patent Office to the above-referenced application in the Notice of Allowance and the "Determination of Patent Term Adjustment" mailed July 28, 2008, is not correct, or at least is not complete. Applicants respectfully request the grant of a minimum Patent Term Adjustment of seven hundred ninety-four (794) days, with an additional term to be added based on the number of days between the payment of the issue fee concurrently with this Request/Petition on October 28, 2008, and the issue date of the patent, which has yet to be determined.

STATEMENT OF FACTS

1. Applicants filed the instant application pursuant to 35 U.S.C. § 371(b) on February 22, 2005, as the U.S. national phase of PCT International Application No. PCT/US03/26317, filed August 21, 2003. The Notice of Acceptance mailed from the U.S. Patent and Trademark Office (the "Office") on October 14, 2005, acknowledged that the application fulfilled all the requirements of 35 U.S.C. § 371 on February 22, 2005.
2. The Office mailed a Restriction Requirement on October 19, 2007. This was the first action under 35 U.S.C. § 132 in the application.
3. As of February 22, 2008 (*i.e.*, three years after the date that the application fulfilled all the requirements of 35 U.S.C. § 371), a patent had not issued from this patent application.
4. During prosecution, there was no request for continued examination, no interference proceeding, no imposition of a secrecy order, and no review by the Board of Patent Appeals and Interferences or a Federal Court. The instant application/patent is not subject to a terminal disclaimer.
5. The Office mailed a Notice of Allowance on July 28, 2008, together with a "Determination of Patent Term Adjustment" indicating that the patent issuing on the present application would be entitled to five hundred forty-five (545) days of Patent Term Adjustment under 35 U.S.C. § 154(b) "[i]f the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice".
6. Applicants submit that there were no circumstances constituting a failure by Applicants to engage in reasonable efforts to conclude processing or examination of the patent application.

7. As the Notice of Allowance and "Determination of Patent Term Adjustment" were mailed on July 28, 2008, and this Request/Petition is filed no later than the payment of the issue fee (which is being filed herewith), but no earlier than the mailing of the Notice of Allowance, as required by 37 C.F.R. § 1.705(b), this paper is timely filed.

8. The Director is authorized to charge the \$200.00 fee for this Request, pursuant to 37 C.F.R. § 1.18(e), to our Deposit Account No. 04-1105 under Order No. 66585(70820).

APPLICANTS ARE ENTITLED TO ADDITIONAL PATENT TERM ADJUSTMENT
UNDER 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b)

9. An inspection of the Patent Term Adjustments page on PAIR, a copy of which is attached hereto as Exhibit A, reveals that the Office accorded, as of July 28, 2008 (the mailing date of the Notice of Allowance and Fee(s) due), five hundred forty-five (545) days of Patent Term Adjustment attributable to USPTO delay under 35 U.S.C. § 154(b)(1)(A). This is consistent with the delay between April 22, 2006 (14 months from the date the present application fulfilled all requirements of 35 U.S.C. § 371) and October 19, 2007 (the date of mailing of an action under 35 U.S.C. § 132), pursuant to 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. § 1.702(a)(1).

10. A further inspection of the Patent Term Adjustments page on PAIR (Exhibit A), reveals that the Office did not accord any days of Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) ("the Three Year Rule"). Because the Office did not accord any days of Patent Term Adjustment under the Three Year Rule, it appears that the Office either (i) has not yet calculated any Patent Term Adjustment due under the Three Year Rule, or (ii) has incorrectly applied the "double-counting" provision of 35 U.S.C. § 154(b)(2)(A).

11. 35 U.S.C. § 154(b)(2)(A) provides:

To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any

adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

12. In a Memorandum Opinion issued on September 30, 2008 in Wyeth v. Dudas, the U.S. District Court for the District of Columbia held that Office's interpretation of § 154(b)(2)(A), as published at 69 Fed. Reg. 34238 and (apparently or potentially) applied to the present patent application/patent, is incorrect. Wyeth v. Dudas, No. 07-1492 (JR), 2008 WL 4445642 (D. D.C. Sept. 30, 2008).

13. The Wyeth court held that "[t]he only way that periods of time can 'overlap' is if they occur on the same day." Id. Accordingly if a delay under § 154(b)(1)(A) occurs on one calendar day, and a delay under § 154(b)(1)(B) occurs on another day, "they do not overlap, and § 154(b)(2)(A) does not limit the extension to one day." Id.

14. Applicants respectfully submit that the five hundred forty-five (545) day delay under § 154(b)(1)(A) does not overlap with the ongoing delay under § 154(b)(1)(B), which is currently tallied at two hundred forty-nine (249) days (as of the date of this paper). The non-overlapping nature of the § 154(b)(1)(A) and § 154(b)(1)(B) delays in this application is illustrated below as Figure 1.

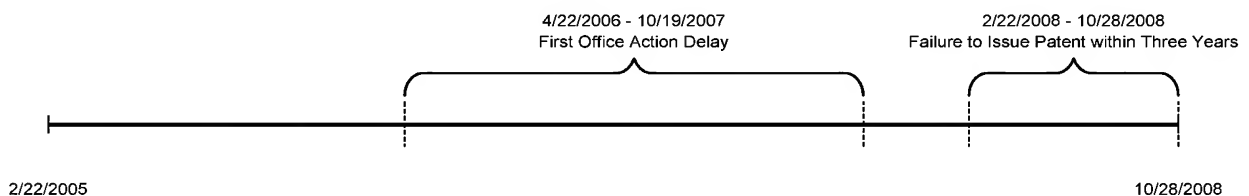


Figure 1

RELIEF REQUESTED

15. Applicants respectfully request that the Office (i) properly calculate the Patent Term Adjustment under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b) to which the present application/patent is entitled, and (ii) grant Patent Term Adjustment equal to the sum of seven hundred ninety-four (794) days (the sum of the delays under §

154(b)(1)(A) (545 days) and § 154(b)(1)(B) (249 days as of the date of this paper), as set forth above), plus the number of days between the payment of the issue fee on October 28, 2008, and the issue date of the patent, which has yet to be determined.

16. If the Office determines that it cannot properly consider this Petition before the patent issues (e.g., due to the need to determine the issue date of the patent before the final Patent Term Adjustment under the Three Year Rule can be calculated), Applicants respectfully request that this petition be held in abeyance by the Office in order to allow Applicants to file a similar or renewed petition within two months of the issue date of the forthcoming patent in accordance with 37 C.F.R. § 1.705(d).

17. Applicants note that further changes to the patent term adjustment of the patent issuing from the subject application may occur as a result of actions occurring subsequent to the Notice of Allowance. This paper is therefore filed without prejudice to the submission of a request to correct patent term adjustment pursuant to the provisions of 37 C.F.R. § 1.705(d)

18. Applicants believe that there are no further fees due in connection with this Petition other than the fee under 37 C.F.R. § 1.18(e). However, if additional fees are due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105 under Order No. 66585(70820).

Dated: October 28, 2008

Respectfully submitted,

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